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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,815	04/28/2006	Jonas Scherble	285453US0PCT	6973
22850	7590	10/28/2010	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			LENIHAN, JEFFREY S	
			ART UNIT	PAPER NUMBER
			1765	
			NOTIFICATION DATE	DELIVERY MODE
			10/28/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/577,815	<b>Applicant(s)</b> SCHERBLE ET AL.	
	<b>Examiner</b> Jeffrey Lenihan	<b>Art Unit</b> 1765	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-13, 16 and 17.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

/ Irina S. Zemel/  
 Primary Examiner, Art Unit 1765

Continuation of 3. NOTE: The proposed amendment introduces new limitations requiring the absence of an insoluble nucleating agent; this limitation was not recited in any previous version of the claims. The proposed amendment therefore requires further search and consideration to determine patentability.

Continuation of 11. does NOT place the application in condition for allowance because:

Arguments regarding the use of insoluble nucleating agents are directed towards a polymer foam defined by a combination of limitations not recited in the currently pending claims, and are therefore not relevant to the patentability of the currently pending claims.

Regarding the amount t-butyl methacrylate: Independent claims 1 and 3 state that the amount of t-butyl methacrylate (TBMA) ranges from 0.01 to 15 pbw; arguments regarding the use of 4.99 pbw TBMA therefore are not commensurate in scope with the invention as recited in the independent claims.

For dependent claims 2 and 4: Per the rationale outlined in paragraph 13 of the Office Action mailed on 8/20/2010, the examples disclosed by Tada do not constitute a teaching away from the reference's broad disclosure of the incorporation of as little as 5 parts TBMA in polymethacrylamide foams. A prima facie case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corp. of America v. Banner* 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). There is only a 0.2% difference between the claimed upper limit of 4.99 parts and the prior art value of 5 parts TBMA. Because the difference between the claimed value and the prior art value is so small, one of ordinary skill in the art would reasonably expect that the properties of a polymethacrylamide foam containing 5 parts TBMA, as rendered obvious by the combination of Geyer and Tada, would not be materially different from the properties of a polymethacrylamide foam containing 4.99 parts TBMA. Applicant is therefore required to provide evidence demonstrating an unobvious difference between the claimed invention and the prior art.

Regarding the allegedly unexpected results: Arguments regarding the allegedly unexpected results with regards to the range recited in the independent claims were addressed in the previous Office Actions, incorporated herein by reference. Regarding the claimed upper limit of 4.99 parts TBMA, comparative example 8 does not contain TBMA; comparisons of inventive examples to comparative example 8 therefore do not establish the criticality of the claimed upper limit of 4.99 parts TBMA. Comparative example 7 comprises 20 parts TBMA whereas the inventive samples contain 1, 2, or 4 parts TBMA (examples 2-4); the difference between the TBMA content of comparative example 7 and the claimed upper limit of 4.99 is therefore at least ~15.16 times greater than the difference between the TBMA content of the inventive examples and the claimed upper limit of 4.99. The cited examples therefore do not establish the criticality of the claimed range.

Applicant states that there is no TBA in component (B) in claims 14 and 15. The examiner notes that claims 14 and 15 are canceled in the currently pending version of the claims.